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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,358	03/16/2001	Gregory L. Merrill	IMD004A	7776

22903 7590 01/13/2004

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EXAMINER
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LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,358

Applicant(s)

MERRIL ET AL.

Examiner

John M. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-25, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-18, 20-25, 38 and 39 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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1. A new Examiner is in charge of this application. Although the previous Examiner approved the amendments made to claims 1 and 9 to place these claims in condition for allowance (see "Interview" section on page 8 of Applicant's remarks filed October 24, 2003), the new Examiner, upon review of such amendments, takes the position that the claims, as currently presented, stand rejected as set forth below. Accordingly, because of the change in position on the claims, this Office Action will not be made final.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-5, 7-12, 15, 20, 22-25, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes et al. (U.S. Pat. 6,038,488) for the reasons set forth in numbered paragraph 2 of the previous Office Action, paper number 12.

Claims 1-4, 7-12, 15, 20, 22-25 and 38 have been previously addressed except for the newly added limitation of "the haptic feedback being output when the elongated member is moved a predetermined distance". Haptic feedback is output when the elongated member is moved some distance in Barnes et al. (col.4, line 66 to col.5, line 4). A predetermined distance can be any distance, which would inherently be met by the Barnes et al. device. In addition, the distance of Barnes et al. is confined by controls (simulation program) in which the distances that are tracked are "predetermined".

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As to claims 5 and 39, haptic feedback in Barnes et al. is output when the distal end of the elongated member is translated through the detector. The elongated member of Barnes et al. can be an actual instrument translated into guide slot (74) (col.9, lines 16-25) which meets the limitation of a working channel that guides the elongated member. Thus, the Barnes et al. device is configured to provide haptic feedback as the instrument is translated through and out of the guide slot.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-4, 7-18, 20-25 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (WO 99/39317) in view of Marcus, "Touch Feedback in Surgery, " *Proceedings of Virtual Reality and Medicine, The Cutting Edge*, September 8-11, 1994, pp.96-97 for the reasons set forth in numbered paragraph 3 of the previous Office Action, paper number 12.

Again, as mentioned above, a "predetermined distance" would be any distance used in the Alexander device, and thus would be anticipated by such.

***Allowable Subject Matter***

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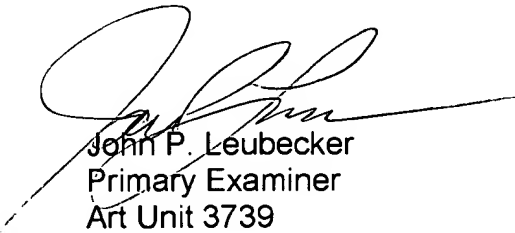
6. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl